

REMARKS

In the Office Action mailed October 17, 2008, claims 11-32 were rejected and claims 1-10 and 33-38 withdrawn in view of a provisional election previously made by Applicant.

Claims 11 and 23 were objected to.

Claims 17-19, 21, 23, 25, 27, and 30 were rejected under 35 USC §112, second paragraph for alleged indefiniteness.

Claims 11-32 were rejected under 35 USC §103(a) for alleged obviousness over WO 02/38686 to Maze et al. in view of US Patent Application Publication No. 2004/0062873 to Jung et al.

Applicant appreciates the careful and thoughtful review of the present application by the Examiner.

In this Response, various clarifying amendments and explanations are presented which are believed to place all of claims 11-32 in condition for allowance. In addition, new claims 39-57 are presented which are also believed to be in condition for allowance.

A. Affirmation of Previous Provisional Election

Applicant hereby affirms the previous provisional election, with traverse, of group II corresponding to claims 11-32.

It is respectfully submitted that it would not be unduly burdensome for the non-elected claims to also be searched and examined. Requiring Applicant to file additional

applications in order for those claims to be examined imposes additional cost and time delays upon Applicant.

B. Objection to Claims Has Been Remedied

Claims 11 and 23 have been amended in accordance with the helpful comments from the Examiner. Specifically, a period was included at the end of claim 11. And the spelling of the term "alkoxylated" was corrected.

It is respectfully submitted that the objections are now moot and should be withdrawn.

C. Rejection of Claims Under §112, Second Paragraph Has Been Remedied

Claims 17-19, 21, 23, 25, 27, and 30 were rejected for alleged indefiniteness under USC §112. Several of these claims included multiple ranges, and so amendments are presented herein in which such multiple ranges have been removed, and re-presented in several of the new claims. Specifically, the narrowing ranges in claim 17 have been cancelled from that claim and re-presented in new claims 39 and 40. The recitation cancelled from claim 18 is re-presented in claim 41. The recitations formerly in claim 19 are re-presented in claims 42 and 43. The recitations formerly in claim 21 are now in claims 44 and 45. The recitations in claim 23 are now set forth in claims 50-52. The recitations formerly in claim 25 are now presented in claims 46-48. The recitations cancelled from claim 27 are presented in claims 53-56. The recitation cancelled from claim 30 is presented in claim 49. And, the recitation in claim 31 is presented in claim 57. No new matter is added by any of new claims 39-57 since

support is found throughout the present application and claims as originally filed. New claims 39-57 are all dependent from independent claim 11 and correspond to the elected group II.

Specifically, claims 23, 25, and 27 have been amended in accordance with the helpful suggestions from the Examiner. Specifically, the term "type" has been removed from claims 23 and 27 and those claims appropriately amended. Claim 25 has been amended to remove the term "in particular." And, the dependency of claim 27 was amended to provide appropriate antecedent basis for the term "thickening agent."

It is respectfully submitted that this ground of rejection has been remedied and should now be withdrawn.

D. Rejection of Claims 11-32 Under §103 Should be Withdrawn

Claims 11-32 were rejected for alleged obviousness based upon WO 02/38686 to Maze et al. in view of US Published Patent Application US 2004/0062873 to Jung et al. In view of the clarifying explanations and amendments presented herein, it is respectfully submitted that the present rejection should be withdrawn.

Independent claim 11 of the present application recites an anticorrosion coating composition comprising at least one particulate metal, a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium and neodymium, in the form of oxides or salts, a binder, and either water optionally associated with one or more organic solvents, or one or more inter-miscible organic solvents. As explained in the present application, it is believed that the presence of at least one of the previously

recited elements in the claimed composition serves to reinforce the efficacy of the anticorrosion protection imparted by the particulate metal in the composition. That is, the anticorrosion properties of a system using sacrificial protection by a particulate metal, can be significantly increased by incorporation of one or more of the noted elements, in the form of oxides or salts. As demonstrated in the testing results presented on pages 8-16 of the application, incorporation of one or more of these elements in the claimed compositions significantly improved their anticorrosion properties, as indicated for example, by resistance to salt spray.

1. Deficiencies of WO '686 to Maze et al.

Maze et al. (WO 02/38686) disclose an anticorrosion coating composition comprising at least one particulate metal, an organic solvent, a thickener, a silane-based binder, molybdenum oxide and water.

The document to Maze et al. entirely fails to teach or even suggest a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium, in the form of oxides or salts.

2. Deficiencies of US '873 to Jung et al.

Jung et al (US 2004/0062873) disclose a paint-like coating comprising a) at least one organic film former containing at least one water-soluble or water-dispersed polymer with an acid value of 5 to 200; b) at least one inorganic compound in particle form; and c) at least one lubricant and/or at least one anti-corrosion agent.

The inorganic compound in particle form b) preferably comprises particles based on at least one compound of aluminium, barium, cerium, calcium, lanthanum, silicon, titanium, yttrium, zinc and/or zirconium, see paragraph [0043] of the '873 publication.

The document Jung et al. entirely fails to teach or even suggest the specific choice of yttrium, zirconium, lanthanum, cerium, praseodymium or neodymium, in the form of oxides or salts, to increase the anticorrosion properties of the paint-like coating. Nor is there any teaching provided by Jung et al. that one or more of the inorganic compounds in particle form taught by Jung et al. would increase the anticorrosion properties of the composition of Maze et al. That is, neither of the cited documents provides any teaching or suggestion of any strategy for increasing the anticorrosion properties of a system using sacrificial protection by a particulate metal.

On the contrary, the document to Jung et al. cites preferred inorganic compounds in particle form, i.e. in item b), which are not rare-earth metals (as in claim 11). For example, Jung et al. teach that calcium in particle form be used in their paint-like coating. Thus, one following the teachings of Jung et al. would be motivated to incorporate calcium and the like in a coating composition instead of the particular elements recited in pending claim 11. That is, Jung et al. actually teach away from the subject matter of claim 11. "A prima facie case of obviousness can be rebutted if the applicant....can show 'that the art in any material respect taught away' from the claimed invention." *In re Haruna*, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001).

Moreover, the document Jung et al. is not directed to an anticorrosion system comprising a particulate metal which sacrifices itself in favor of the metal parts to be protected. Instead, Jung et al. describe a paint-like coating composition. For at least

this reason, it is doubtful that the teachings of Jung et al. are properly combinable with those of Maze et al.

Furthermore, it is respectfully submitted that upon further review, the Examiner will appreciate that it is not appropriate to apply the '873 publication to Jung et al. to the claims of the present application for at least the following reasons. Jung et al. explain that their paint-like coating "as far as possible is also free from organic and inorganic acids." See paragraph [0015] of the '873 publication to Jung et al. Jung et al. explain the reason for avoiding the use of acids as:

[0013] Resin mixtures are known for which resins are blended with inorganic acids in order thus to obtain a pickling attack as well and hence a better contact of the resin coat directly with the metallic surface. These compositions have the drawback that, owing to the pickling attack, contamination occurs during the contacting of the treatment liquid (dispersion) to the substrate. This leads to the accumulation of metals in the treatment liquid and, as a result, to a permanent change in the chemical composition of the treatment liquid, thereby significantly impairing the corrosion protection. These metals are dissolved by the pickling attack out of the metallic surface of the substrate to be treated.

Paragraph [0013] of the '873 publication to Jung et al.

In contrast, the claimed compositions in certain embodiments may contain from 0.1% to 10% by weight of a mineral acid such as boric acid. Pending claims 31 and 57 specifically recite this aspect.

Thus, a formulator attempting to identify an anticorrosion coating composition (as recited in the pending claims) which may contain 0.1% to 10% of an acid, would not be motivated to consider the teachings of the '873 publication to Jung et al. since that publication teaches avoiding the use of acids. Since the '873 publication to Jung et al. teaches away from the present invention, that document should not be relied upon for the present rejection (refer to the previous citation).

3. Resulting Combination of Maze et al. and Jung et al. Reached by Impermissible Hindsight Reconstruction

Apparently, the Examiner justifies the citation and reliance upon the publication to Jung et al. by a mention by Jung et al. that their composition may contain a lubricant and that the claimed composition may also comprise a lubricant, (see lines 15-18 on p. 6 and claim 28). Thus, once having identified the Jung et al. document due to its mention of a lubricant, the Examiner attempts to combine it with the document to Maze et al. Then, the Examiner refers to listings of various inorganic compounds used by Jung et al. for particles in their paint-like compositions, (see paragraph [0043] of the '873 publication). The present rejection is then urged by pointing to the listing of these inorganic compounds as somehow teaching the recitation in claim 11 for "a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium and neodymium, in the form of oxides or salts." This manner of reconstructing the claimed subject matter from the art is not permitted.

Specifically in this regard, the Examiner's rationale for combining the documents to Jung et al. and Maze et al. is as follows:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made **to have an anti-corrosion coating composition for metal parts by Maze et al.** with a reinforcing agent for the anticorrosion properties of the composition such as yttrium, zirconium, lanthanum, cerium, praseodymium and neodymium, in the form of oxides or salts **and a lubricating agent to obtain a self-lubricated system as taught by Jung et al.** in order to improve the anti-corrosion properties of parts treated without using a composition based on reinforcing agent in the formulation of the coatings with less toxic risk and less adverse consequences for the environment.

Page 12 of the Office Action (emphasis added).

However, it must be recognized that this practice is simply an attempt to recreate the claimed invention by hindsight reconstruction. *It is well established that the claimed invention cannot provide the motivation for combining references.* "It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claim as a blueprint. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). "Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260 23 USPQ2d 1780 (Fed. Cir. 1992). The motivation to combine must not come from the present invention.

Moreover, assuming that the documents to Maze et al. and Jung et al. were properly combined (which Applicant respectfully disputes), the resulting combination still fails to teach the claimed subject matter. That is, the document to Jung et al. fails to remedy the deficiency of Maze et al. to teach "a reinforcing agent for the anticorrosion properties of the composition selected from the group consisting of yttrium, zirconium, lanthanum, cerium, praseodymium, in the form of oxides or salts." The mention of several inorganic compounds in particle form by Jung et al. does not provide the

necessary teaching to properly reject the claims. As previously explained, Jung et al. is not directed to an anticorrosion system comprising a particular metal which sacrifices itself in favor of the metal parts to be protected. Instead, Jung et al. describe a paint-like coating composition. In addition, Jung et al. teach away from the present invention since they instruct that their compositions should be free from acids.

Therefore, the manner by which the present rejection was reached is not in accordance with long standing precedent of the Court of Appeals for the Federal Circuit. For at least this reason, the present rejection is unsupported and must be withdrawn. Moreover, assuming for purposes of argument that the teachings of Maze et al. and Jung et al. were properly combined, the resulting combination still fails to teach the claimed subject matter.

In conclusion, a person of ordinary skill in the art would not have been motivated by either of the documents to Maze et al. or Jung et al., taken singularly or in combination, to prepare an anticorrosion coating composition according to the subject matter as recited in independent claim 11. Since independent claim 11 is believed to be patentable over the cited art, so too are claims 12-32 dependent therefrom.

E. Conclusion

In view of the foregoing, it is respectfully submitted that all claims 11-32, and new claims 39-57, are patentable over the cited references, and in condition for allowance. New claims 39-57 are all dependent or ultimately dependent upon independent claim 11, and so contain all of the recitations of that claim.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. CRE-17902.

Respectfully submitted,

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